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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENNETT M. RICHARD
and JOHN T. BROOME

Appeal 2008-1084
Application 10/695,205
Technology Center 3600

Oral Hearing Held: October 23, 2008

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and JOSEPH A. FISCHETTI, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

STEVEN ROSENBLATT, ESQUIRE
Duane Morris, LLP
1200 Southwest Freeway, Suite 2150
Houston, TX 77027

ALSO PRESENT:

CHARLES GREENHUT
ERIC PICO

The above-entitled matter came to be heard on Thursday, October 23, 2008, commencing at 9:04 a.m., at the United States Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Paula Lowery, Notary Public.

PROCEEDINGS

THE CLERK: Good morning. Calendar Number 31, Mr. Rosenblatt.

JUDGE PATE: Good morning, Mr. Rosenblatt. We've had the opportunity to look at this case beforehand, so we're up to speed on the technology. We'd like to hear your arguments for patentability.

MR. ROSENBLATT: Thank you, Judge. I appreciate it. Good morning, everyone.

As I said in my brief, this is really a simple case and probably going to be the shortest appeal brief ever filed. There's one issue, one claim, and one reference at stake here, and this is -- Echols is the 102 rejection.

Echols teaches in great detail how to make a screen that's ultimately used downhole in a well. He also talks about running it in oil and expanding it.

Screen expansion downhole is frequently used to reduce the size of an annular space around the screen so that control of production of things like sand can be better initiated with less gravel filler around there. In fact, it could eliminate the use of gravel altogether.

The claims in Echols -- because the issue of what does the preamble mean here -- are also to a method of manufacturing, even though Echols discusses what happens later.

1 The claim in question -- claim 1 doesn't talk about running the screen
2 that's already fabricated into the hole. It talks about how to make the screen.

3 Echols understands the expansion technology exists for screens, but
4 yet when he discusses his fabrication method his example shown in figure 3
5 is a weld 58. As explained in the application, welding is a bad thing if
6 you're going to expand downhole.

7 The use of screens could cause differential pressures on them if they
8 clog up, could put stresses on the end. Expansion to attach the filter
9 assembly to the base pipe is a more certain way of keeping them together.
10 Once they separate, you don't have any screening action at all.

11 So we went a few rounds during prosecution, which I'm sure you're
12 familiar with, and I could not convince this examiner that there is a
13 difference between a method of making something and a method of using
14 something.

15 A method of using something in a well bore requires you to run the
16 thing into the well bore. Otherwise, the method is useless. There's no
17 running it down the well bore in my claim 1.

18 My claim 1 focuses on how you attach the filter assembly to a base
19 pipe, which is part of the tubular string that goes in the hole. My preamble
20 says that just like Echols' preambles in all his claims says that, too.

21 These claims focus on how to make it, even though he talks about
22 how to run it. I'm trying to claim how to make it.

23 What's novel about this is the attachment is done by expansion,
24 eliminating the welding, eliminating a hazard of failure downhole. That's
25 pretty much it.

26 JUDGE PATE: Do you have any questions?

1 JUDGE FISCHETTI: No.

2 JUDGE PATE: Judge Bahr?

3 JUDGE BAHR: I don't think so.

4 JUDGE PATE: We have no questions. We're going to take this case
5 under advisement.

6 MR. ROSENBLATT: Thank you, sir.

7 JUDGE PATE: Thank you for your brief.

8 (Whereupon, the proceedings at 9:09 a.m. were concluded.)